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In re Application of :
Aya Jakobovits et al :
Serial No.: 10/001,469 : PETITION DECISION
Filed: October 31, 2001 :
Attorney Docket No.: 511582002420 :

This is in response to the petition under 37 CFR 1.181, filed August 12, 2005, requesting entry of an amendment after Final Office action for purposes of Appeal. The delay in acting on this petition is regretted, however it was only brought to the attention of the deciding official recently.

BACKGROUND

A review of the recent file history shows the examiner mailed a Final Office action to applicants on December 16, 2004, setting forth an objection as to the presentation of a Sequence and SEQ ID NO in the claims, a new rejection under 35 U.S.C. 112, second paragraph, for use of an indefinite term, "activity" and a rejection under 35 U.S.C. 112, first paragraph, for lack of enablement. The rejection of "activity" was that the type of activity referred to was not clear – the metes and bounds were not defined.

Applicants replied on February 16, 2005, amending claims 48 and 55 to overcome the objection set forth and further defining "activity" as comprising "101P3A11-mediated cAMP accumulation or the downstream signaling effects thereof." All of the rejections were addressed in the reply and a declaration under 37 CFR 1.132 was also submitted.

The examiner mailed an Advisory Action to applicants on June 17, 2005, one day after the six month statutory response period expired and four months after the reply was filed. The examiner denied entry of the amendment as raising new issues requiring further consideration or search. In a six page letter accompanying the Advisory Action the examiner states only that "the language 'downstream signaling effects thereof' requires new 112, second and first rejections." No further explanation is offered. The balance of the remarks address the affidavit showing and states that it is not entered as the amendment is not entered.

Applicants filed a Notice of Appeal on June 13, 2005.

This petition was filed August 17, 2005, requesting entry of the amendment and affidavit.

DISCUSSION

Applicants state that the amendment proffered by the February 16, 2005, reply responded to the objections and the new 35 U.S.C. 112, first paragraph, rejection set forth and should have been entered. Applicants give specific reasons in the petition and in the reply as to why the amendments should be entered. The examiner stated that the amendment would not be entered as it raised new issues, identifying "downstream signaling means" as the new issue. The examiner, however, did not indicate or explain why this phrase raised new issues under 35 U.S.C. 112, first or second, paragraph. Refusal to enter an amendment after Final Office action requires a clear statement of reasons why the amendment will not be entered since it responds to a new rejection made in the Final Office action, not just a mere statement that new issues are raised.

Further, the examiner delayed four months before communicating to applicants that the amendment would not be entered thus preventing applicants from filing a further reply which may have addressed such concerns without requiring the filing of a Notice of Appeal or an Appeal Brief. Such delay further mitigates for entry of the amendment.

DECISION

The petition is **GRANTED**.

The amendment and affidavit filed February 16, 2005, are entered. Applicants' Appeal Brief should be directed to the claims as amended therein. The time for filing the Appeal Brief as determined by the filing of a Notice of Appeal remains as set therein or as extended under 37 CFR 1.136(a).

There is no fee for this petition and the petition fee paid of \$400.00 will be credited to applicants' Deposit Account No. 03-1952, as directed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



George C. Elliott
Director, Technology Center 1600